| | Application No. | Applicant(s) |
|---|---|---|
| ***Advisory Action*** <br> ***Before the Filing of an Appeal Brief*** | 10/807,636 | CHEN ET AL. |
| | **Examiner** | **Art Unit** |
| | NAM HUYNH | 2617 |

*-- The **MAILING DATE** of this communication appears on the cover sheet with the correspondence address --*

THE REPLY FILED <u>01 July 2008</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

   a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.

   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

      Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ They raise the issue of new matter (see NOTE below);

   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

      NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: _____.

   Claim(s) withdrawn from consideration: _____.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>See Continuation Sheet.</u>

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

  /George  Eng/
  Supervisory Patent Examiner, Art Unit 2617

Continuation of 11. does NOT place the application in condition for allowance because:  Applicant asserts that the combination of Kallin, Ho, and Funato and that the motiviation to combine the references amount to impermissable hindsight.  In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning.  But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.  See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The Examiner respectfully disagrees that the combination of the three references amount to hindsight.  With respect to the combination of Kallin and Ho, Kallin pertains to adaptively selecting a paging area to page a mobile terminal wherein a base station or the network maintains a record  of the last base station accessed by the mobile terminal.  Ho pertains to a mobile terminal that maintains a movement history by recording cell ID of visited cells in a movement history stack.  When a movement threshold is reached, the mobile terminal performs a location update and removes all the cell IDs in the movement history stack except for the current cell. The Examiner views the combination of Kallin and Ho as the mobile terminal of Ho operating in the network of Kallin.  In Kallin, each base station identity for which the mobile terminal accesses is recorded for future paging/location purposes.  In Ho, the mobile terminal does not perform a location update unless a movement threshold is reached.  Thus if Kallin records the base station or cell ID when the mobile station of Ho performs a location update when the movement threshold is reached, the result would be the reduction of necessary location updates, which in turn reduces network signaling and increases network resources and efficiency.

With respect to the combination of Kallin and Ho, with Funato, Ho teaches that the cell IDs are removed from the history stack, but is silent to what happens to the removed cell IDs.   Funato pertains to maintaining a current location table and a history location table.  Funato teaches that when a mobile terminal moves from one paging area, information from a current location table is moved to a previous location table, thus broadly teaching maintenance of current information and previous information in two distinguished tables and moving the current information to a previous information table when an update occurs.  Thus if the mobile terminal in the combination of Kallin and Ho moves the cell IDs recorded in the movement history stack when a location update occurs to another table or list, one of ordinary skill in the art would recognize that this information may at one time in the future be valuable or needed by the network to perform particular functions such as billing or movement tracking.  Furthermore the saving of erased or deleted data in case of future need is readily known in the art.

Applicant asserts that the combination of Kallin, Ho, and Funato does not teach the limitation that the MS moves cells identified in the first list, other than the cell in which the MS last registered, to a second list.  The Examiner respectfully disagrees.  With respect to Ho and Funato, the movement history stack of Ho renders the first list.  When the movement threshold is reached, the current cell ID or cell in which the MS last registered is maintained.  The cell IDs removed from the movement history stack, or the cells identified in the first list other than the cell the MS last registered, are then stored in another table or list as taught by Funato, thus teaching the required claim limitations.